

Notice of Allowability

Application No.

10/715,329

Applicant(s)

ZHAO ET AL.

Examiner

David J. Venci

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to November 8, 2005.
2. ☒ The allowed claim(s) is/are 1-7,9,11-29 (renumbered 1-27, respectively).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.
THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____. |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

EXAMINER'S AMENDMENT

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Attorney Robert Hanson on December 1, 2005.

In the Claims:

Please cancel claims 8, 10 and 30-32.

In claim 22, please delete "sepharose" and replace with "SEPHAROSE"

In claim 22, please delete "tentagel" and replace with "TENTAGEL"

In claim 22, please delete "agrogel-Wang" and replace with "AGROGEL"

In claim 25, please delete "+" appearing underneath the molecular formula.

In claim 26, please delete "+" appearing underneath the molecular formula.

In claim 28, please delete "+" appearing underneath the second molecular formula.

In the Specification:

On page 4, line 14, please delete "sepharose" and replace with "SEPHAROSE"

On page 4, line 15, please delete "tentagel" and replace with "TENTAGEL"

On page 4, line 15, please delete "agrogel-Wang" and replace with "AGROGEL"

On page 16, line 4, please delete "be" appearing at the end of line 4.

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REASONS FOR ALLOWANCE

The following is an examiner's statement of reasons for allowance:

Examiner's statement of indication of *Allowable Subject Matter*, set forth in Office Action dated April 6, 2005, is incorporated herein.

Applicants' amendment and argumentation set forth in Applicants' reply filed November 8, 2005, are fully persuasive and sufficient to overcome all rejections of record. Specifically, Examiner observes that the primary focus of the teachings of Spielmann et al. (US 6,284,910) pertain to the design and synthesis of FPP analogs *for the purposes of FTase inhibition*. The primary focus of the teachings of Spielmann et al. does not appear to pertain to isolating or detecting FPP incorporation. Thus, motivation to combine the teachings of Spielmann et al. with Saxon & Bertozzi is lacking.

In addition, Examiner is in agreement with Applicants' position that "[t]here is not established that Saxon and Bertozzi provides any motivation to one of ordinary skill in the art to apply its teachings pertaining to glycoproteins (i.e. a hydrophilic environment) to farnesylated proteins (i.e., a hydrophobic environment)" (see Applicants' reply, filed November 8, 2005, p. 16, third paragraph).

Ting (US 2004/0209317) is cited for her description of the Staudinger reaction (see paragraph [0090]) and geranylgeranyl diphosphate labels (see paragraph [0104]), relevant to claims 1 and 28. Ting does not describe a method resulting in the production of an isoprenylated protein, as required in claim 1, step b). Ting does not describe the synthetic substrates recited in claim 28.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Venci whose telephone number is 571-272-2879. The examiner can normally be reached on 08:00 - 16:30 (EST). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long Le can be reached on 571-272-0823. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

David J Venci
Examiner
Art Unit 1641

djv



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12/09/05